

TRADEMARK: HAMILTON
SER. NO.: 88/489575

ARGUMENTS

The Examiner has refused to register the Applicant's Mark as primarily merely a surname under Section 2(e)(4) of the Trademark Act and has cited a pending application for the mark HAMILTON on goods and services in classes 5, 7, 10, 16 and 35 as a potential obstacle to the approval of Applicant's Mark. For the reasons discussed below, the Applicant submits that mark HAMILTON has acquired distinctiveness and should be registrable under Section 2(f) of the Trademark Act, and further that the citation to the pending application should be withdrawn because the goods and services in that application are unrelated to the goods in the instant application.

A. APPLICANT'S MARK HAS ACQUIRED DISTINCTIVENESS

The Applicant submits that the mark HAMILTON in the instant application has acquired distinctiveness based on Applicant's ownership of a prior registration for the mark HAMILTON on closely related goods including watches, chronographs, clocks, watches, watch bracelets etc. The Applicant has therefore entered the following statement below:

The mark has become distinctive of the goods as evidenced by ownership of active U.S. Registration No. 5168258 on the Principal Register for the same mark for sufficiently similar goods and/or services

The Applicant submits that the goods are related because the goods in the instant application, like the goods in the prior registration, are chronometers and similar devices worn on the wrist, and parts and accessories for those devices. Consumers will recognize the mark HAMILTON as more than merely a surname based on Applicant long use and

registration of HAMILTON for the goods recited in the prior registration. The relatedness of standard watches and smart watches, wrist computers and software for those devices is shown by the attached third-party registrations showing the use of the same mark for both types of goods.

In view of the foregoing, Applicant requests approval of the mark for registration under Section 2(f) of the Trademark Act.

B. NO LIKELIHOOD OF CONFUSION WITH PRIOR APPLICATION

The Examining Attorney has cited a pending application for the mark HAMILTON for goods in classes 5, 7, 10, 16 and 35 as a potential obstacle to the approval of the Applicant's Mark. The Applicant submits that the goods and services in the cited application are unrelated to the goods of the instant Applicant which, as amended below, are limited to "computers worn on the wrist, smartwatches, computer software for computers worn on the wrist and smartwatches, namely, downloadable software for recording, organizing, receiving and transmitting alerts, messages, emails, reminders, and text, data, audio, image and digital files." In contrast, the goods and services covered by the prior application not only do not include any goods in Class 9, they are also specifically designed and directed to medical use. In a response filed by the prior applicant on March 5, 2020, the prior applicant highlighted this point in the arguments it submitted against confusion with other HAMILTON registrations. In particular, the prior applicant states:

The Examining Attorney is requested [sic] to applicant's substantially revised description of services, **which has been narrowed significantly to make it clear that the services are exclusively marketed and provided to customers in the medical field ...** The presumption cited by the Examining Attorney, that the applicant's and registrant's services are "presumed to travel in the same channels of trade to the same class of purchasers" is overcome by the applicant's much

narrowed description of its services, especially when viewed in combination with **the fact that applicant's customers are limited to the medical field, where a higher degree of care is exercised.** Regarding the higher degree of care exercised in the medical profession, see: *4 McCarthy on Trademarks and Unfair Competition* § 23:102, and cases cited therein.

(Emphasis added) Thus, the prior Applicant has made it clear that the goods in that application are highly specialized goods which are limited to use in the medical field. The Applicant's computers worn on the wrist, smart watches and related software are wholly unrelated to these goods.

Accordingly, applicant respectfully requests that the potential citation to Application Serial No. 79/233739 be withdrawn.